

**Amendment and Response**

Page 8 of 12

Serial No.: 10/623,359

Confirmation No.: 5048

Filed: 18 July 2003

For: BIOMEDICAL ELECTRODE WITH CURRENT SPREADING LAYER

---

**Remarks**

The Office Action mailed 16 March 2006 has been received and reviewed. Claims 1, 14, 23, and 30 have been amended and claims 3, 15, 25, and 32 have been canceled. As a result, claims 1, 2, 4-14, 16-24, 26-31, and 33-35 remain pending. Reconsideration and withdrawal of the rejections are respectfully requested.

**The 35 U.S.C. §102 Rejection**

Claims 1-5, 7, 9, 10, 12, 14-16, 18-21 were rejected under 35 U.S.C. §102(b) as being anticipated by Ferrari (U.S. Patent No. 5,824,033). This rejection is respectfully traversed.

Independent claim 1 has been amended to recite that "the biomedical electrode is free of adhesive between the metallic layer and the conductive polymeric sheet" (from canceled claim 3). Independent claim 14 has been amended to recite that "the biomedical electrode is free of adhesive between the current spreading layer and the conductive polymeric sheet" (from canceled claim 15).

In contrast, Ferrari discloses a current distributing mat 27 that is attached to the upper surface of a sheet electrode 21 (a conductive polymeric sheet) using conductive adhesive. *See, e.g.,* Ferrari, col. 5, lines 5-58. No other technique for attaching the current distributing mat to the upper surface of the sheet electrode is disclosed.

For at least this reason, Applicants respectfully submit that pending claims 1, 2, 4, 5, 7, 9, 10, 12, 14, 16, 18-21 are patentable over Ferrari. Reconsideration and withdrawal of this rejection are, therefore, respectfully requested.

Although not required to overcome the rejection, Applicants also respectfully traverse the assertion made in connection with this rejection that "[t]he subject matter of claim 2 is considered to be inherent in the device of Ferrari." No basis for this assertion is identified and Applicants reserve the right to traverse this assertion in the future.

## Amendment and Response

Page 9 of 12

Serial No.: 10/623,359

Confirmation No.: 5048

Filed: 18 July 2003

For: BIOMEDICAL ELECTRODE WITH CURRENT SPREADING LAYER

---

**The 35 U.S.C. §103 Rejections**

Claims 6, 13, 17, 23-35 were rejected under 35 U.S.C. §103(a) as being unpatentable over Ferrari (U.S. Patent No. 5,824,033). This rejection is respectfully traversed.

To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. M.P.E.P. § 2143.

Applicants submit that a *prima facie* case of obviousness of claims 6, 13, 17, 23-35 over Ferrari has not been established.

As noted above, independent claims 1 and 14 have been amended to recite the absence of adhesive between the metallic layer (claim 1) or the current spreading layer (claim 14) and the upper side of the conductive polymeric sheet. Independent claim 23 has also been amended to recite that "the biomedical electrode is free of adhesive between the metallic layer and the conductive polymeric sheet" (from canceled claim 25) and independent claim 30 has been amended to recite that "the biomedical electrode is free of adhesive between the current spreading layer and the conductive polymeric sheet" (from canceled claim 32).

Ferrari, in contrast, teaches that the current distributing mat is attached to the upper surface of the sheet electrode using only conductive adhesives. No suggestion or motivation for modifying the inventions of Ferrari to reach the inventions recited in claims 6, 13, 17, 23-35 has been identified in connection with this rejection. Rather, it is asserted that claims 6, 13, and 17 are "design choices" and that claims 23-25 are "obvious." These assertions do not meet the requirements for a proper *prima facie* case of obviousness. *See, e.g.*, M.P.E.P. § 2143.

For at least these reasons, Applicants respectfully submit that a *prima facie* case of obviousness has not been established with respect to claims 6, 13, 17, 23-35. Reconsideration and withdrawal of this rejection is, therefore, respectfully requested.

## Amendment and Response

Page 10 of 12

Serial No.: 10/623,359

Confirmation No.: 5048

Filed: 18 July 2003

For: BIOMEDICAL ELECTRODE WITH CURRENT SPREADING LAYER

---

Claims 11 and 22 were rejected under 35 U.S.C. §103(a) as being unpatentable over Ferrari (U.S. Patent No. 5,824,033) in view of Itoh et al. (U.S. Patent No. 5,362,420). This rejection is respectfully traversed.

Applicants submit that a *prima facie* case of obviousness of claims 11 and 22 over Ferrari in view of Itoh et al. has not been established.

As noted above, independent claims 1 and 14 (from which claims 11 and 22 depend) have been amended to recite the absence of adhesive between the metallic layer (claim 1) or the current spreading layer (claim 14) and the upper side of the conductive polymeric sheet.

Ferrari, in contrast, teaches that the current distributing mat is attached to the upper surface of the sheet electrode using only conductive adhesives. Itoh et al. does not address the shortcomings of Ferrari et al. with respect to claims 1 and 14. Nor is any suggestion or motivation identified in the Office Action that would lead one of ordinary skill in the art to modify the inventions of Ferrari to reach the inventions recited in claims 1 and 14 (and, thus, claims 11 and 22).

For at least these reasons, Applicants respectfully submit that a *prima facie* case of obviousness has not been established with respect to claims 11 and 22. Reconsideration and withdrawal of this rejection is, therefore, respectfully requested.

Claim 8 was rejected under 35 U.S.C. §103(a) as being unpatentable over Ferrari (U.S. Patent No. 5,824,033) in view of Axelgaard (U.S. Patent No. 5,785,040). This rejection is respectfully traversed.

Applicants submit that a *prima facie* case of obviousness of claim 8 over Ferrari in view of Axelgaard has not been established.

As noted above, independent claim 1 (from which claim 8 depends) has been amended to recite the absence of adhesive between the metallic layer and the upper side of the conductive polymeric sheet.

## Amendment and Response

Page 11 of 12

Serial No.: 10/623,359

Confirmation No.: 5048

Filed: 18 July 2003

For: BIOMEDICAL ELECTRODE WITH CURRENT SPREADING LAYER

---

Ferrari, in contrast, teaches that the current distributing mat is attached to the upper surface of the sheet electrode using only conductive adhesives. Axelgaard does not address the shortcomings of Ferrari et al. with respect to claim 1. Nor is any suggestion or motivation identified in the Office Action that would lead one of ordinary skill in the art to modify the inventions of Ferrari to reach the invention recited in claim 1 (and, thus, claim 8).

For at least these reasons, Applicants respectfully submit that a *prima facie* case of obviousness has not been established with respect to claim 8. Reconsideration and withdrawal of this rejection is, therefore, respectfully requested.

**Amendment and Response**

Page 12 of 12

Serial No.: 10/623,359

Confirmation No.: 5048

Filed: 18 July 2003

For: BIOMEDICAL ELECTRODE WITH CURRENT SPREADING LAYER

---

**Summary**

It is respectfully submitted that pending claims 1, 2, 4-14, 16-24, 26-31, and 33-35 are in condition for allowance and notification to that effect is respectfully requested. The Examiner is invited to contact Applicants' Representatives, at the below-listed telephone number, if it is believed that prosecution of this application may be assisted thereby.

Respectfully submitted by

Mueeting, Raasch &amp; Gebhardt, P.A.

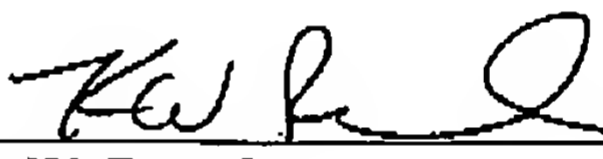
P.O. Box 581415

Minneapolis, MN 55458-1415

Phone: (612) 305-1220

Facsimile: (612) 305-1228

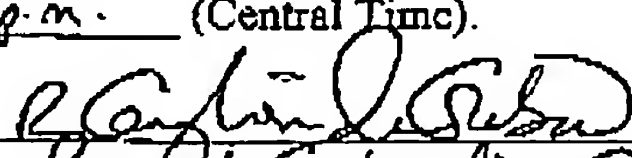
17 JULY 2006  
Date

By:   
Kevin W. Raasch  
Reg. No. 35,651  
Direct Dial (612) 305-1218

---

**CERTIFICATE UNDER 37 CFR §1.8:**

The undersigned hereby certifies that the Transmittal Letter and the paper(s), as described hereinabove, are being transmitted by facsimile in accordance with 37 CFR §1.6(d) to the Patent and Trademark Office, addressed to Mail Stop Amendment, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450, on this 17th day of July, 2006, at 2:04 p.m. (Central Time).

By:   
Name: Rachel Englandi-Gebhardt

---